REMARKS

Claims 1-18 are pending in the present application. Claims 1-18 have been amended herewith. Reconsideration of the claims is respectfully requested.

Amendments were made to the specification to correct errors and to clarify the specification. No new matter has been added by any of the amendments to the specification.

I.   Objection to Drawing

The Examiner objected to the drawing, stating reference characters 110, 444, 446 and 448 are not mentioned in the description. Applicants have amended the description herewith to include mention of these reference characters. Therefore, the objection to the drawing has been overcome.

II.   Objection to Specification

The Examiner objected to the Specification disclosure, stating (1) item number 146 on page 6, line 16 is not found in the drawings, and (2) item number 100 is used to reference both "SAN" on page 7, line 4 and "SAN fabric" on page 7, line 6. As to objection (1), Applicants have amended the Specification herewith to eliminate the reference to item number 146. As to objection (2), Applicants have amended the Specification herewith to eliminate the word "fabric". Therefore, the objection to the Specification has been overcome.

III.   35 U.S.C. § 112, Second Paragraph

The Examiner rejected Claims 2-4, 6-13 and 15-18 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicants regard as the invention. This rejection is respectfully traversed.

As to Claims 3, 4, 8, 9, 12, 13, 17 and 18, the Examiner states "the request" does not have sufficient antecedent basis. Applicants have amended such claims herewith to instead recite "the command", or to eliminate "the request" altogether.

As to Claims 2, 6, 11 and 15, the Examiner states that "similar" is a relative term which renders the claim indefinite. Applicants have amended such claims to eliminate the objectionable terminology.

As to Claims 7 and 16, the Examiner states that "dissimilar is a relative term which renders the claim indefinite. Applicants have amended such claims to eliminate the objectionable terminology.

Therefore the rejection of Claims 2-4, 6-13 and 15-18 under 35 U.S.C. § 112, second paragraph has been overcome.

IV.   35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over Spinney et al. (U.S. Patent No. 5,390,173) (hereinafter "Spinney) in view of Pettey et al. (U.S. Patent No. 6,594,712) (hereinafter "Pettey"). This rejection is respectfully traversed.

With respect to Claim 1, Applicants urge that none of the cited references teach or suggest the claimed feature of "translating the command and sending the translated command to an internal device". As can be seen, the translating and sending steps synergistically co-act together, as a command is translated and this translated command is then sent to an internal device. In rejecting this aspect of Claim 1, the Examiner cites Spinney col. 5, line 3 and lines 30-33. Applicants urge that neither of these cited passages teach or suggest translating a *command* – rather it merely describes parsing and decoding a packet, where the packet *data* is placed into an intermediate FIFO (col. 5, lines 1-4). Because Spinney teaches the switching or routing of *data* from one network node to another network node – and not the processing of received *commands*, as claimed – there would be no reason for Spinney to translate a command as it does not process received commands. Applicants have amended Claim 1 to further clarify this distinction. In particular, amended Claim 1 recites that the command is translated and sent to an internal device within the internal subnet. This new translated command is performed within the internal subnet. Because Spinney teaches a switch/router function that adds and strips headers to data packets that pass through the switch/router such that they can be processed quicker, there would have been no motivation to modify the teachings of

Spinney to include nodal processing of commands as such a modification would add delay and thus *increase latency* of such an intermediate switch/router node, which are normally designed to minimize internal processing in order to *reduce latency* (Spinney col. 1, lines 31-34 and 47-56; col. 3, lines 2-19). Although a device may be capable of being modified to run the way [the patent applicant's] apparatus is claimed, there must be a suggestion or motivation *in the reference* to do so. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). There is simply no suggestion or other motivation to modify the teachings of Spinney to include command translation and performance of such translated commands within the internal subnet. Thus, it is urged that amended Claim 1 is not obvious in view of the cited references.

Applicants initially traverse the rejection of Claims 2-4 for similar reasons to those given above with respect to Claim 1 (of which Claims 2-4 depend upon).

Further with respect to Claim 2, Applicants urge that none of the cited references teach or suggest the claimed feature of "sending a message to the external subnet indicating a completion status of the command". Because Spinney is directed to a method for switching or routing data packets from one network node to another network node, and does not teach or otherwise suggest receiving of commands for internal processing, there would be no reason for Spinney to send, from the internal subnet, a message indicating a completion status of the received command. Thus, Claim 2 is further shown to not be obvious in view of the cited references.

Further with respect to Claims 3 and 4, Applicants have amended such claims to recite that the method is performed in an endnode, which is different from a switch/router as taught by the cited Spinney reference (Specification page 6, lines 26-28). Thus, amended Claims 3 and 4 are further shown to not be obvious in view of the cited references as switches/routers primary function is to switch and route, and not to process received commands, as claimed.

With respect to Claim 5, Applicants urge that none of the cited references teach or suggest the ability of an internal subnet to appear as a single device to the external subnet. In rejecting this aspect of Claim 5, the Examiner states that such feature is inherent because when networked storage devices are arranged in subnets, each subnet automatically appears as though it were a single device to the devices outside of the

subnet. Applicants urge that while this may be a possibility, it is not a certainty. "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting *Hansgirg v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)). "To establish inherency," the Federal Circuit recently stated, "the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999); see also *Continental Can Co. U.S.A., Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268 [20 USPQ2d 1746] (Fed. Cir. 1991). Such inherency may not be established by "'probabilities or possibilities.'" *Continental Can*, 948 F.2d at 1269 (quoting *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (C.C.P.A. 1981)). As described by Applicants in the present Specification at page 2, lines 8-12, facilitating communication between dissimilar bus and device architectures is becoming more difficult, as device managers must keep track of an increasing diversity of devices hooked into various system fabrics. As the number and diversity of devices increases, more resources are expended in an attempt to account for these devices, and it would therefore be desirable to have a method for reducing the resources devoted to tracking individual devices in different computer subnets, and allow those subnets to present themselves as single entities to outside device managers during communication and data access. Thus it is urged that, and contrary to the Examiner's assertion, it was not a certainty that each subnet automatically appears as though it were a single device to the devices outside of the subnet, and therefore this claimed feature is not inherent. Accordingly, Claim 5 is shown to have been erroneously rejected under 35 U.S.C. § 103(a), as all claimed elements are not taught or suggested by the cited references[1]. In any event, Applicants have amended Claim 5 to further emphasize how this claimed feature is not inherent to the teachings of the cited references. Spinney teaches receipt

---

[1] To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974). If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

and internal processing of packets having a plurality of different target addresses (col. 7, lines 13-27; col. 11, lines 36-46; col. 12, lines 37-55 and 61- 68). Notably, the Spinney CAM look-up and hash lookup features require individual and unique target addresses for devices in order to function properly (col. 12, line 37 – col. 14, line 59), and thus a person of ordinary skill in the art would not have been motivated to modify the teachings contained therein in accordance with the claimed invention recited in Claim 5 as such look-up functions based on different received target addresses would no longer function. It is thus urged that Claim 5 is not obvious in view of the cited references.

Applicants initially traverse the rejection of Claims 6-9 for reasons given above with respect to Claim 5 (of which Claims 6-9 depend upon).

Applicants further traverse the rejection of Claim 6 for similar reasons to those given above with respect to Claim 1 pertaining to intermediate node processing and associated latency issues.

Applicants further traverse the rejection of Claims 8 and 9 for similar reasons to the further reasons given above with respect to Claims 3 and 4.

Applicants traverse the rejection of Claims 10-13 for similar reasons to those given above with respect to Claim 1.

Applicants further traverse the rejection of Claim 11 for similar reasons to the further reasons given above with respect to Claim 2.

Applicants further traverse the rejection of Claim 12 and 13 for similar reasons to the further reasons given above with respect to Claims 3 and 4.

Applicants traverse the rejection of Claims 14-18 for similar reasons to those given above with respect to Claim 5.

Applicants further traverse the rejection of Claim 15 for similar reasons to those further reasons given above with respect to Claim 6.

Applicants further traverse the rejection of Claim 17 and 18 for similar reasons to the further reasons given above with respect to Claims 3 and 4.
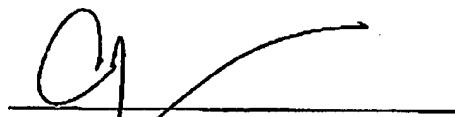
Therefore, the rejection of claims 1-18 under 35 U.S.C. § 103(a) has been overcome.

V.   Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: _3/30/05_

Respectfully submitted,

Cathrine K. Kinslow
Reg. No. 51,886
Wayne P. Bailey
Reg. No. 34,289
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorneys for Applicants

Page 13 of 13
Weber et al. – 09/965,292